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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,207	04/16/2004	Jerry H.C. Lee	25341A	1155
97072                      7590                      02/16/2011 MacMillan, Sobanski & Todd, LLC One Maritime Plaza, Fifth Floor, 720 Water Street Toledo, OH 43604				
EXAMINER				
MATZEK, MATTHEW D				
ART UNIT		PAPER NUMBER		
1786				
MAIL DATE		DELIVERY MODE		
02/16/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/826,207

**Applicant(s)**

LEE ET AL.

**Examiner**

MATTHEW D. MATZEK

**Art Unit**

1786

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3.5-15, 17-19, 21-23, 25, 29-39 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36-39, 45 and 47 is/are allowed.
- 6) ☒ Claim(s) 1-3.5-15, 17-19, 21-23, 25, 29-35, 42-44, and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-532)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**Response to Amendment**

1. The amendment dated 11/24/2010 has been fully considered and entered into the Record. Claims 1, 5, 8, 10, 11, 12, 32, and 36 have been amended. New claims 42-47 have been added. Claims 4, 16, 20, 24, 26-28, 40, and 41 have been canceled leaving claims 1-3, 5-15, 17-19, 21-23, 25, 29-39, and 42-47 are currently active.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 recites the limitation "roofing covering" in a roof covering. There is insufficient antecedent basis for this limitation in the claim.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 5-15, 17-19, 21-23, 25, 29-35, 42-44, and 46 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejected claims are directed to a roof covering wherein the tear strength of the roof covering is increased by at least about 5% as measured by ASTM D 1922 compared to the same roof covering without the various sulfur-containing materials in the sizing. The instant specification, however, only provides support for a roof covering that is a “shingle”, wherein the tear strength of the “shingle” is increased by at least 5% as measured by ASTM D 1922 compared to the same roof covering without the various sulfur-containing materials added. Applicant is directed to amend the instant claims to recite a roof covering that is a roofing shingle with increased tear strength.

#### **Allowable Subject Matter**

4. Claims 36-39, 45, and 47 are allowable for the reasons set forth in the previous office action in conjunction with remarks set forth in Applicant's most recent response.

#### **Response to Arguments**

5. Applicant's arguments filed 11/24/2010 have been fully considered but they are not persuasive.
6. Applicant argues that the new matter rejection is an after-thought based on an unduly technical application of the written description requirement and that it is well accepted that new limitations added to patent claims need not be set forth verbatim in an original application in order for the written description requirement to be satisfied. Applicant argues that "Examiner has the initial burden of presenting by a preponderance of the evidence why a person skill[ed] (sic.) would not recognize in Applicant's disclosure a description of the invention defined in the claims." In re Wertheim, 541 F.2d 257, 263, 191 U.S.P.Q. 90,97 (C.C.P.A. 1976).
7. There two different ways in which the one of ordinary skill in the art would not recognize in Applicant's disclosure a description of the invention defined in the claims: whether a roof covering is commensurate in scope with a shingle, and whether a roofing shingle with its increased tear strength as disclosed in the instant specification provides adequate support for the

instantly claimed roof covering with the same increase in tear strength. Applicant has clearly demonstrated that there is a difference in scope between a roof covering and roofing shingle by further limiting the claimed roof covering as a “shingle” in dependent claims 5 and 8. If there is no difference in scope between the claimed “roof covering” and “shingle” the use of the “shingle” limitation in both claims would be redundant and confusing because the claimed article has only been referred to as a roof covering in all preceding claims and must necessarily be referring to an article that is has a narrower scope than the “roof covering” to be appropriate. Therefore, the limitation should be stricken from claims 5 and 8 if it bears no significance on the scope of claim because it is redundant and confusing.

8. If the limitation is intended to further limit the claims and further define the roof covering of claim 1, then the limitation should be left in the claim and be recognized to be materially different from a “roof covering.” A “shingle” that is materially different from the claimed “roof covering” necessarily has a difference in scope, and in this instance a narrower scope. In the same way that a single specie may not provide support for the recitation of its genus in a claim, “shingle” may not provide support for a “roof covering”, because there are multiple roof coverings that are not “roofing shingles” – roll roofing, built-up roofing, etc. – and broadening the scope of a “shingle” to include “roof covering” would result in an improper expansion of the intended meaning of “shingle.”

9. Applicant argues that it is now well-accepted that new limitations added to the patent claims need not be set forth in an original application in the exact same words in order for the written description requirement to be satisfied. As Examiner has pointed out in the response to the previous argument, the issue of whether or not the written description requirement is satisfied

is not a matter of mere semantics, rather Applicant has intentionally demonstrated a distinct difference in scope between a “roof covering” and “shingle” throughout the specification. The difference in scope as laid out by Applicant demonstrates that a “shingle” is but one specie of the “roof covering” genus; therefore, a “shingle” does not meet the written description requirement for the broader “roof covering” for the reasons presented supra.

10. Applicant argues that no experienced chemist in the chemistry of roofing products would seriously consider Applicants not to have been in possession of the claimed invention and that the increase in tear strength of at least 5% was fairly contemplated by Applicant to be applicable to all other “roof coverings” not just “shingles.” As Examiner has pointed out in the response to the previous arguments, the issue of whether or not the written description requirement is satisfied is not a matter of mere semantics, rather Applicant has intentionally demonstrated a distinct difference in scope between a “roof covering” and “shingle” throughout the specification. The difference in scope as laid out in Applicant’s own words demonstrates that a “shingle” is but one specie of the “roof covering” genus and only the aforementioned shingle possesses the improvement in tear strength; therefore, a “shingle” does not meet the written description requirement for the broader “roof covering” with improved tear strength for the reasons presented supra.

11. Applicant has directed Examiner to MPEP § 2163.05 I for a better understanding as to their argument that the written description requirement has been met. Examiner has reviewed the section and again would like to point out that the issue, as interpreted by Examiner is not one of mere semantics, or nuance of language, rather, a difference in scope due to the specific language selected by Applicant. The difference in scope as laid out in Applicant’s own words

demonstrates that a "shingle" is but one specie of the "roof covering" genus and only the aforementioned shingle possesses the improvement in tear strength; therefore, a "shingle" does not meet the written description requirement for the broader "roof covering" with improved tear strength for the reasons presented supra. The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]." See *Enzo Biochem*, 323 F.3d at 966, 63 USPQ2d at 1615. "A patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when ... the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed." In re *Curtis*, 354 F.3d 1347, 1358, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004).

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after



the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW D. MATZEK whose telephone number is (571)272-2423. The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571.272.1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew D Matzek/  
Examiner, Art Unit 1786

/Norca L. Torres-Velazquez/  
Primary Examiner, Art Unit 1786

